

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 1, 2008. At the time of the Office Action, Claims 1-21 were pending in this Application. Claims 1-15 were rejected. Claims 1-5, 8, and 11-14 have been amended. Claims 6 and 7 have been cancelled without prejudice or disclaimer and Claims 16-21 were previously withdrawn due to an election/restriction requirement. Applicants respectfully request reconsideration and favorable action in this case.

Drawing objections

The drawings were objected to for failing to show every feature of the invention as specified in the claims 6 and 7. Applicant cancelled claims 6 and 7 without prejudice.

Rejections under 35 U.S.C. § 102

Claims 1-5, 8-12 and 15 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by German Patent No. 19715487 by Johannes Fitzner et al. ("*Fitzner*"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Applicant amended independent claim 1 to include limitations of former claim 13. Former Claim 13 was not anticipated by *Fitzner*. Hence, Applicant believes that amended claim 1 is now allowable in view of *Fitzner*. Applicants respectfully submit that the dependent Claims 2-5, 8-12, and 15 are allowable at least to the extent of the independent Claim 1 to which they refer, respectively. Thus, Applicants respectfully request

reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Rejections under 35 U.S.C. §103

Claims 7 and 13-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fitzner* and further in view of International Publication No. WO2004/004021 by Markus Mohr ("*Mohr*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Fitzner* and in view of U.S. Patent Application Publication No. 2002/0053860 by Shinya Mitarai et al. ("*Mitarai*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant amended independent claim 1 to include that the holder comprises a top plate, a bottom plate, and a first rib and a second rib, wherein the first and second rib couple

said top and bottom plate to form said holder, the top plate and the bottom plate each comprise cutouts to receive a single piezo stack and wherein holder is furthermore designed to receive two associated connection pins.

With respect to former claim 13 which included similar limitations, the Examiner stated that this claim is unpatentable over *Fitzner* in view of *Mohr*. However, the Examiner did not provide any explanation or argument why this combination renders former claim 13 obvious. thus, at this time it is not clear on which grounds this rejection is based. Applicant respectfully requests a detailed explanation as to why a combination of *Fitzner* and *Mohr* renders the present independent claim obvious.

To this end, Applicant would like to point out that the prior art discussed in *Mohr* with respect to Fig. 3 does not disclose all the elements as claimed let alone how these elements are interconnected. *Mohr* clearly explains Fig. 3 and states that a piezo stack 1 is first provided with insulating foils 6 and then wires 2 and 3 are electrically connecting the individual piezo layers of stack 1 with respective pins 4 and 5. *Mohr*, page 1, lines 10-18. This contacted stack is then inserted into a top housing part 8 and a bottom housing part 9. and a silicon material is used to cast the device. *Mohr*, page 1, lines 18-22. *Mohr* particularly states: "*In Fig. 3 the silicon mass is shown in an exploded view in its theoretical geometry after having been hardened.*" Thus, *Mohr* lacks the elements of t least the first and second rib coupling the top and bottom plate.

In summary, *Fitzner* in view of *Mohr* does not render the amended independent claim 1 obvious. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.


CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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Date: June 30, 2008

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